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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/148,090 09/03/98 SMITH

S

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PM21/1026

EXAMINER

BUTLER, D

ART UNIT

PAPER NUMBER

3613

DATE MAILED:

10/26/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/148,090

Applicant(s)

S. Gregory Smith

Examiner

DCButler

Group Art Unit

3613

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on the filing of this application
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

1. Note the attached Form PTO-892 and PTO-945.
2. All the prior art from the parent applications has been considered. The prior art from parent copending application No. 08/794,100 filed on February 3, 1997 has been made of record.
3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).
- A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
4. Claims 1-8 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8 of copending Application No. 08/794,100 filed on February 3, 1997. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.
5. Claims 1-8 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 08/794,100 filed on February 3, 1997 which has a common inventor with the instant application.

Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application.

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This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,437,354 to Wolf(354) or claims 1-3 of U.S. Patent No. 5,529,153 to Wolf(153) in view of Hanna(076).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims differ from the inventions defined by the noted patents in the feature of remote connection of parts. The instant claimed invention is an obvious variation of the invention defined in the noted patents.

The secondary reference to Hanna(076) teaches connecting a strut 9 remotely to a source or chamber 101+ by way of a hose.

It would have been obvious at the time the invention was made to one having ordinary skill in the art to which the invention pertains to modify the invention defined by the claims of each of the principal patents to Smith(354) and Smith(153) to form the tilt-control thereof into two parts as taught by Hanna(076) connected together by a fluid pressure hose in that remotely locating one or more of the elements relative to each other provides for facilitating more efficient use of space in the vehicle and provides for securement of the liquid and/or air pressure device in an area of the vehicle or its frame less affected by environmental concerns such as heat, water, dirt, etc. Also, it would have been obvious to one having ordinary skill in the art to make the above modification since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Nerwin v. Erlichman, 168 USPQ 177, 179.

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8. Claims 7-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,437,354 to Wolf(354) or claims 1-3 of U.S. Patent No. 5,529,153 to Wolf(153) in view of Hanna(076) as combined above in paragraph 7 further in view of Hamilton(5026248) or Komossa et al.(4765445).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims differ from the inventions defined by the noted patents in the feature of remote connection of parts. The instant claimed invention is an obvious variation of the invention defined in the noted patents.

Re claims 7-8, claims 1-16 of U.S. Patent No. 5,437,354 to Wolf(354) and claims 1-3 of U.S. Patent No. 5,529,153 to Wolf(153) recite the invention except for the feature of the device having a pressure relief or pressure release valve for permitting the release of fluid pressure should the pressure exceed a pre-set or predetermined value .

It would have been obvious at the time the invention was made to one having ordinary skill in the art to which the invention pertains to modify the invention defined by the claims of each of the principal patents to Smith(354) and Smith(153), as modified, to include a pressure relief or pressure release valve as taught by each of the references to Hamilton(5026248) and Komossa et al.(4765445), for permitting the release of fluid pressure should the pressure exceed a pre-set or predetermined value .

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas C. Butler whose telephone number is (703) 308-2575. The examiner can normally be reached on Monday-Friday from 6:30 a.m. to 3 p.m., unless on approved leave. If attempts to reach the examiner by telephone are not immediately successful, the examiner suggests that applicants' representative leave a message on the examiner's answering machine or with receptionist at (703) 308-1113 requesting that the examiner phone applicants' representative to resolve any inquiry that concerns those matters falling within the examiner's purview.

If attempts to reach the examiner by telephone are still unsuccessful, the examiner's supervisor, Robert Oberleitner, can be reached at (703) 308-2569.

Any inquiry of a general nature or relating to the status of this application or proceeding should not be directed to the examiner but rather should be directed to the receptionist whose telephone number is (703) 308-1113.

***** NOTICE *****
RESPONSE BY FACSIMILE

Applicant(s) is/are **encouraged to respond** to this Office action directly to Technology Center 3600 by facsimile transmission at:

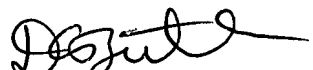
Technology Center 3600 Facsimile Number

(703) 305-7687

The facsimile transmission service is provided to improve communication with our customers. If this service is utilized **please include/use the attached Technology Center cover sheet**. A confirmation copy **should not be mailed** to the Patent and Trademark Office, see 37 CFR 1.6(d) and 1.8(b).

If surface mail is your preferred delivery option please address your amendment or response to this final Office Action to: Commissioner of Patents and Trademarks; Washington, D.C. 20231

By facsimile transmitting all Office action responses to the above telephone numbers, processing time of the responses is reduced. This will result in more timely responses by the Office and should result in fewer requests for extensions of time.


DOUGLAS C. BUTLER
PRIMARY EXAMINER
AU3613

10/23/98